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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,719	08/01/2000	Teruna J. Siahaan	30406	5579

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EXAMINER
HADDAD, MAHER M

ART UNIT	PAPER NUMBER
1644	20

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/629,719	SIAHAAN ET AL.	
	Examiner	Art Unit	
	Maher M. Haddad	1644	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1,2,6-9,35,37,38 and 42*.

   Claim(s) withdrawn from consideration: *4,5 and 39-41*.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments, filed 5/16/03 (Paper No. 19), have been fully considered, however

Claims 9 and 42 stand rejected under 35 U.S.C. 112, first paragraph, enablement.

Contrary to Applicant's assertions, the specification fails to provide sufficient guidance as to which core structure of SEQ ID NO: 8 is essential for maintain its binding ability and which changes can be made in the structure of SEQ ID NO: 8 and still maintained the same function.

Claims 9 and 42 stand rejected under 35 U.S.C. 112, first paragraph, written description.

The specification fails to disclose adequate written description as to which core structure of SEQ ID NO: 8 is essential to maintain its functional activity and which changes can be made in the structure of SEQ ID NO: 8 and still maintained the same function.

Claims 1-2, 6-9, 35, 37-38 and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gursoy et al (April 1999) (IDS reference No.2) in view of Nagy et al (1993).

Examiner's position is the same as set forth in the previous office action mailed 3/11/03 (Paper N. 18).

Further, Applicant argues that combination of Gursoy and Nagy is base on improper hidsight. Applicant further argues that the combination of Gursoy and Nagy results in a very large number of possible conjugates, therefore, they fail to render obvious claims to the specific SEQ ID NOs:1-8 conjugated to a drug. Applicnat argues that since the combination of Gursoy and Nagy results in a very large number of possible conjugates, they fail to render obvious claims to the specific SEQ ID NOs:1-8 conjugated to a drug.

Applicant argues that conjugation of methotrexate to N-terminus of ICAM-1 peptides may change the conformation of the cIBR peptide; Gursoy does not consider the conformational issue. Applicnat further agures that Nagy cyclized the LH-RH peptides using two terminal cys residues they did not use Penicillamin at the N-terminus.

However, specific statements in the references themselves which would spell out the claimed invention are not necessary to show obviousness, since questions of obviousness involves not only what references expressly teach, but what they would collectively suggest to one of ordinary skill in the art.. See CTS Corp. v. Electro Materials Corp. of America 202 USPQ 22 (DC SNY); and In re Burckel 201 USPQ 67 (CCPA).

The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See MPEP 2144.

Further, Gursoy et al teach a fluorescence-labeled conjugate of SEQ ID NO:2 (Pen cyclic peptide) without any conformational changes. Thus, conjugating SEQ ID NO:2 with methotrexate would be expected to act as the fluorescence-labeled conjugate of the same peptide.

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